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Application Number	10/699,175
Filing Date	October 31, 2003
First Named Inventor	Bianchi et al.
Art Unit	3738
Examiner Name	Suzette Jaime J Gherbi
Attorney Docket Number	MSDI-434/PC316.08

ENCLOSURES (Check all that apply)

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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Krieg DeVault LLP		
Signature			
Printed name	Kevin J. Huser		
Date	October 16, 2007	Reg. No.	56,379

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Bianchi et al.

Serial No. 10/699,175

Filed: October 31, 2003

OPEN INTERVERTEBRAL SPACER

)
) Before the Examiner

) Suzette Jaime J Gherbi

)
) Group Art Unit 3738

)
) October 16, 2007

**PETITION UNDER 37 CFR §1.181 FOR WITHDRAWAL OF
FINALITY OF PREMATURE FINAL REJECTION**

MAILSTOP PETITIONS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

For the reasons set forth herein, Applicants submit that the Office Action dated August 16, 2007, is a premature final rejection, and respectfully request withdrawal of finality of the rejection. No fees are believed to be required for this request, however, if any fees are deemed necessary, please charge said fees to Deposit Account No. 12-2424, but not to include the payment of any issue fee.

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Kevin J. Huser

Name of Registered Representative

Signature

October 16, 2007
Date of Signature

PETITION UNDER 37 CFR §1.181

Serial No. 10/699,175

Attorney Docket No. MSDI-434

Page 1 of 6

REMARKS

Applicants will address the substantive assertions made in the outstanding Office Action dated August 16, 2007, under separate cover. The purpose of this paper is to request withdrawal of the Examiner's holding of finality of the rejection. Reconsideration of the holding of finality in view of the following remarks is respectfully requested.

Statement of Facts

On August 11, 2004, a first substantive Office Action was issued in the present case, with claims 72, 91 and 111 being rejected, *inter alia*, under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,371,988 to Pafford et al. Applicants filed a response on December 13, 2004 traversing, *inter alia*, the rejection of claims 72, 91 and 111 as being anticipated by Pafford. In response to Applicants' December 13, 2004 reply, a Final Office Action was issued on March 14, 2005, in which claims 72, 91 and 111 were again rejected, *inter alia*, under 35 U.S.C. §102(e) as anticipated by Pafford.

On September 14, 2005, Applicants submitted a Request for Continued Examination (RCE) and a response to the March 14, 2005 final Office Action, in which arguments were again presented traversing, *inter alia*, the rejection of claims 72, 91 and 111 as being anticipated by Pafford. None of the pending claims were further rejected in view of any cited references until a further non-final Office Action issued on August 2, 2006. Particularly, in the August 2, 2006 Office

Action, claims 72-90, 134 and 135 were rejected, *inter alia*, under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,258,125 to Paul et al. and under 35 U.S.C. §103(a) as being unpatentable over Paul in view of U.S. Patent No. 6,530,955 to Boyle et al. However, no rejections of the claims in view of Pafford were maintained, nor had any further rejections of the claims in view of Pafford been raised until the issuance of the outstanding Office Action.

On December 4, 2006, Applicants submitted a response to the August 2, 2006 Office Action in which the new claim rejections were traversed. On March 19, 2007, a final Office Action was issued which maintained the rejections of the claims set forth in the August 2, 2006 Office Action. Applicants filed a response to the March 19, 2007 Office Action on June 13, 2007 and an additional RCE on July 18, 2007.

On August 16, 2007, an Office Action issued in which claims 72, 91 and 111 were rejected, *inter alia*, under 35 U.S.C. §102(e) as being anticipated by Pafford. Applicants note that this rejection was not present in either of the August 2, 2006 and March 19, 2007 Office Actions, nor did Applicants file any amendment or information disclosure statement which necessitated the new ground of rejection. Despite being the first substantive action after the July 18, 2007 RCE and presenting a new ground of rejection, the outstanding Office Action was made final.

Remarks

As will be established through citation to various sections of the Manual of Patent Examining Procedure (“MPEP”) below, Applicants submit that the finality of the outstanding Office Action is improper. In order for a rejection in a first action after an RCE to be final, it is necessary that the rejection would have been made final in a next Office Action issued before the filing of the RCE. In the instant case, the rejection of claims 72, 91 and 111 as being anticipated by Pafford is a new rejection not necessitated by any amendment(s) or information disclosure statement(s) filed by Applicants, and therefore it could not be made final in a next Office Action issued before filing of the RCE.

More particularly, As stated in MPEP §706.07(h), “[t]he action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met.” MPEP §706.07(b) instructs:

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. (emphasis added).

Applicants respectfully submit that a rejection of claims 72, 91 and 111 as being anticipated by Pafford could not have been made final if it had been entered as the next Office Action after the March 19, 2007 Office Action. More particularly, MPEP §706.07 instructs:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

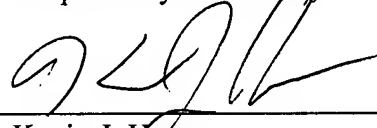
The rejection of claims 72, 91 and 111 as being anticipated by Pafford clearly differs from the grounds of rejection set forth in the March 19, 2007 Office Action and therefore Applicants submit that it constitutes a new ground of rejection. Moreover, Applicant has not filed any amendment(s) or information disclosure statement(s) which necessitated these new grounds raised in the outstanding Office Action. Accordingly, the finality of the August 16, 2007 Office Action is improper.

Closing

In view of the above, Applicants respectfully submit that the holding of finality in the outstanding Office Action is premature, and respectfully requests withdrawal of finality of same. Applicants are responding substantively to the outstanding Action under separate cover.

Respectfully submitted,

By: _____



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